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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,138	07/29/2003	Charles D. Gollnick	14206US02	7159

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EXAMINER	
SOBUTKA, PHILIP	

ART UNIT	PAPER NUMBER
2618	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/630,138	GOLLNICK ET AL.	
	Examiner	Art Unit	
	Philip J. Sobutka	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 38-55 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 38-55 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 25 May 1999 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 3/04, 3/04, 8/05.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 38,39,40 and 41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,3,4 and 2 respectively of U.S. Patent No. 5,940,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims require the terminals to be data collection terminals. Official Notice it taken that it is notoriously well know in the art that mobile communication units need not collect data. Therefore it would have been obvious to one of ordinary skill in the art to modify the patented claims as shown in the instant claims in order to use the system with communication units that

were not data collection units. Note that while the other limitations are somewhat restated, the essential elements are otherwise the same.

2. Claims 42,43,44,and 45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,3,4 and 2 respectively of U.S. Patent No. 5,940,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims require the terminals to be data collection terminals. Official Notice it taken that it is notoriously well know in the art that mobile communication units need not collect data. Therefore it would have been obvious to one of ordinary skill in the art to modify the patented claims as shown in the instant claims in order to use the system with communication units that were not data collection units. Note that while the other limitations are somewhat restated, the essential elements are otherwise the same.

3. Claims 46, 47,48 and 50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,940,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims require the terminals to be data collection terminals. Official Notice it taken that it is notoriously well know in the art that mobile communication units need not collect data. Therefore it would have been obvious to one of ordinary skill in the art to modify the patented claims as shown in the instant claims in order to use the system with communication units that were not data collection units. Note that while the other limitations are somewhat restated, the essential elements are otherwise the same.

4. Claims 49 and 51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 5,940,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims require the terminals to be data collection terminals. Official Notice it taken that it is notoriously well know in the art that mobile communication units need not collect data. Therefore it would have been obvious to one of ordinary skill in the art to modify the patented claims as shown in the instant claims in order to use the system with communication units that were not data collection units. Note that while the other limitations are somewhat restated, the essential elements are otherwise the same.

5. Claims 52 and 53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,940,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims require the terminals to be data collection terminals. Official Notice it taken that it is notoriously well know in the art that mobile communication units need not collect data. Therefore it would have been obvious to one of ordinary skill in the art to modify the patented claims as shown in the instant claims in order to use the system with communication units that were not data collection units. Note that it would be obvious to perform the method of the instant claims using the system of the patented claims.

6. Claims 54 and 55 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,940,771.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims require the terminals to be data collection terminals. Official Notice it taken that it is notoriously well know in the art that mobile communication units need not collect data. Therefore it would have been obvious to one of ordinary skill in the art to modify the patented claims as shown in the instant claims in order to use the system with communication units that were not data collection units. Note that while the other limitations are somewhat restated, the essential elements are otherwise the same. Note that it would be obvious to one of ordinary skill in the art that patented claim terminal would not require the specific base station of the patent claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 47,50,53,54,55, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tymes (US 5,029,183) in view of Hoff (US 5,168,271).

Tymes teaches a data collection network comprising: a plurality of roaming terminals (fig 1, items 15); a plurality of base stations (Tymes fig 1, items 12,13,14); the plurality of roaming terminals and the plurality of base stations each having wireless transceivers; and each of said roaming terminals selectively deactivates its wireless transceiver for one of a plurality of selected time intervals (Tymes see especially col 3, lines 1-15). Tymes lacks a teaching of the remote terminal automatically receiving message indications from the base. Hoff teaches an arrangement for transmitting message indications from a base while saving battery power. Hoff's arrangement includes a plurality of base stations that transmit information packets periodically at each of defined intervals; the plurality of roaming terminals and the plurality of base stations each having wireless transceivers (Hoff see especially fig 2A); and each of said roaming terminals selectively deactivates its wireless transceiver for a consecutive plurality of the defined intervals, and then activates its wireless transceiver to allow receiving the information packets', wherein each of said roaming terminals attempts to synchronize activation of its wireless transceiver to receive information packets transmitted by at least one of the plurality of base stations (Hoff see especially col 25, line 60 col 26, line 65); and wherein the information packets transmitted by the plurality of base stations comprise pending message indications (Hoff see especially col 4, line

58 – col 5, line 25, col 17, lines 15-35, col 22, lines 40-65). It would have been obvious to one of ordinary skill in the art to modify Tymes to use the arrangement of Hoff in order to allow the remotes to automatically receive messages from the base while still saving battery power.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Sobutka whose telephone number is 571-272-7887. The examiner can normally be reached on Monday - Friday, 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on 571-272-4177.

11. The current fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and **571-273-8300** will be the only facsimile number recognized for "centralized delivery".

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has

rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4/28/06

Philip J Sobutka

(571) 272-7887

PHILIP J. SOBUTKA
PATENT EXAMINER